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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,017	12/04/2003	Eric Lawrence Barsness	ROC920030312US1	7311

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IBM CORPORATION
ROCHESTER IP LAW DEPT. 917
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EXAMINER

STEELMAN, MARY J

ART UNIT	PAPER NUMBER
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2191

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/728,017

Applicant(s)

BARSNESS ET AL.

Examiner

Mary J. Steelman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,9,13-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,13-17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to Amendments and Remarks received 11/29/2006. Per Applicant's request, claims 1, 8, 9, 13-17, and 19 are amended. Claim 3 is cancelled. Claims 1, 2, and 4-20 are pending.

Specification

2. In view of the amendment to the Specification, the prior objection is hereby withdrawn.

Claim Objections

3. In view of the amendment to claim 17, the prior objection is hereby withdrawn.

In view of the amendment to claim 19, the prior objection is hereby withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. In view of the amendment to claims 13-17, the prior 101 rejection is hereby withdrawn.
5. Claims 1, 2, and 4-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to an invention that is not useful. The disclosed invention is inoperative and therefore lacks utility.

Examiner does not understand how this invention works.

Claim 1 recites:

receiving an operation, a selection of a block of code, and a selection of a paste location;

(presumably this references an IDE editor command that selects a block of code and a paste location)

determining that the block of code has a size greater than a threshold;

creating a method that comprises the block of code; and

(the IDE editor creates a method and copies in the block of code?)

adding an invocation of the method at the paste location.

(at the paste location, insert an instruction that calls the newly created code method? Where is the newly created code method located? Is the code block 'cut' from its former location? Is the newly created code method block inserted into the 'paste location'? How is the instruction sequence to find the 'paste location' to execute the method invocation? i.e. Is a 'goto' / call type of instruction inserted at the original code block location?)

Claim 2 recites:

Replacing the block of code at a copy location with an invocation of the method.

(replacing the block of code at a copy location – How did the block of code get to a 'copy location'? Was it 'cut' from its original location and pasted into a copy location / temporary copy location?)

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Once the block of code is at the copy location, it is replaced with an invocation of the method?

Is this a second invocation? This second invocation is at the copy location, while the first invocation is at the paste location?)

Claim 6 recites:

Wherein the operation comprises a copy and paste operation.

(Is the block of code ever 'cut' from it's original locations or is it only copied into a new method block?)

Claim 7 recites:

Wherein the operation comprises a punch-out operation.

(Referencing the Specification, page 10, line 13, does 'punch-out' mean a 'cut and paste' type of operation, with an invocation (method call) inserted at the location where the code block was cut? The method call is invoking the newly created method and code block which has been inserted in its new location?

Claim 8:

Similar to claim 1 except

means for replacing the block of code with an invocation of the method.

(An invocation / call to the newly created method, is inserted at the original location of the block of code? 'Replacing' infers that the block of code was 'cut'? After the method comprising the block of code was created, where is it to be located? At the paste location?)

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Claim 9:

Means for adding the invocation of the method at the paste location.

(Is this the first invocation? It is already added at the original location of the block of code. A duplicate invocation is added at the paste location? How does that work?)

Claim 13:

See 9 above. (The same invocation is inserted at the original location of the block of code and additionally at the paste location? How does that work?)

Claim 17:

Similar arguments as above.

112 Rejections

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 2, and 4-20 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections

8. Examiner withholds claim examination at this time pending clarification of claim limitations and invention. Upon receipt of clarification, an office action will be issued.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Mary Steelman

02/14/2007

Mary Steelman
Primary Examiner